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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,257	01/09/2001	Wofgang Gunther	201013US0PCT	8345

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/720,257

Applicant(s)

GUENTHER et al

Examiner

MEDLEY

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-14 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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The disclosure is objected to because of the following informalities: The term "Propoxilate" should be corrected in the title to read as ---Propoxylate---, as well as, in line 3 from the bottom of page 12 of the disclosure.

Appropriate correction is required.

Claim 13 objected to because of the following informalities: The term "additive" in line 2 should be corrected for its spelling .

Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 3 (and its dependent claims 4-8), independent claim 10 (and its dependent claims 11-13) and independent claim 14 improperly refer back to independent claim 1 for the propoxylate compound. The said propoxylate should be set forth in each independent claim. Claim 13 directed to a concentrate improperly depends and refer back to claim 10 directed to an additive mixture. Claim 14 is indefinite for providing for the use of a propoxylated additive with a detergent without setting forth any steps involve in the process.

Claim 14 provides for the use of at least one propoxylate in combination with at least one detergent additive, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim

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is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 10-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thomas EP0704519A1, note page 4 lines 19-24 for fuel compositions for Internal Combustion Engines (ICE) comprising a major amount of liquid hydrocarbon fuel and a (i) propoxylate additive of formula I where n is 8-30 and R<sup>1</sup> include iso-tridecanol, page 3 lines 41-46 the additive mixture further include a (ii) polyisobutylamine detergent additive having a MW of 500-1000 page 2, lines 56-58, Example 2 and page 3, line 15, wherein (i) to (ii) is anticipated by the range of 5:95 to 85:15, preferably 20:80 to 80:20, page 4, lines 8-9, the total proportion of (i) plus (ii) is 450-600 mg/kg fuel, note Examples 2, 4, 6 and 7, the use of the additive as a lubricant composition, and as an intake valve cleaner additive for fuel composition in ICE is known, page 4, lines 28-30.

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Claims 1-8 and 10-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Daly EP 0878532A1.

Daly teaches a fuel composition comprising a major amount of liquid hydrocarbon, page 4 lines 26, comprising a propoxylated additive, page 4, lines 48 to end and page 5 lines 25-29, a detergent, page 6 lines 44-52 and Example 9 of Table 1, and (i) and (ii) present in amount of 100-10,000 mg/kg fuel, page 9, line 27-33, is used to prevent or reduce the formation of intake valve or combustion chamber deposits or to remove their deposits, note page 9 lines 40-42.

Claims 1, 2 and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Polss 3,901,665.

Polss teaches a fuel composition for ICE, claim 1 and column 4 lines 32-34 comprising a major amount of liquid hydrocarbon fuel and 0.004-0.006 parts by weight of a propoxylate wherein  $n = 4-20$  and  $R^1$  is 10-20, note column 2, lines 39-60 and claim 1, and the inclusion of a detergent additive, note polymer A column 2, the additive prepared as a concentrate, column 3, line 51, and the additives are used as a known valve cleaner additive, column 1, lines 57-61.

Claims 1-3, 5-6, 10 and 13-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Aiello et al 5,006,130.

Aiello et al teach fuel compositions for ICE, abstract, comprising a major amount of liquid hydrocarbon fuel and a (i) proxylate additive b(iv) where  $n$  is at least 7 and  $R^1$  is an alkyl group up to 20 carbon atoms, note column 5 lines 53-61 and claims 1 and 8-15, in 80-110 ppm of the fuel, column 6, line 45, and (ii) an aliphatic alkylene polyamine additive, column 3 line 63 to column 3, lines 1-2 and  $d^3$  in Table I of column 8, wherein (i) and (ii) is added to the fuel

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between 100 and 10,000 mg/kg fuel, column 6 line 45, the additive is prepared as a concentrate, column 7, line 57, and the additive is known as an intake valve cleaner, abstract and claim 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas EP 0704,519A1.

Thomas is silent to explicit teachings to a specific propoxylate having  $n = 15$  and  $R^1$  is straight-chain or branched C13 alkyl group. It is the examiner's position that the selection of the specific propoxylate is within the propoxylate of Thomas wherein  $n$  is 8-30 and  $R^1$  includes iso-tridecanol, page 3 lines 41-46. The propoxylates of Thomas known as carrier oils would also exhibit their intake valve cleaning properties in the fuel composition. In the absence of evidence to the record to the contrary the claim is deemed prima facie obvious.

The prior art cited but not relied upon further teaches fuel compositions comprising propoxylated additives and detergents of the same nature as claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703 308-2518. The examiner can normally be reached on Monday-Friday from 7:30 A.M. to 6:30 P.M..

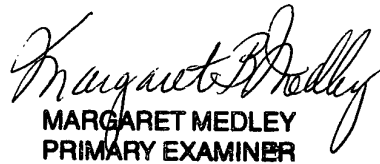
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703 306-2777. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703 305-7718 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

Medley/af  
March 11, 2002

  
**MARGARET MEDLEY**  
**PRIMARY EXAMINER**